

## **REMARKS**

### **Claim Rejections – 35 U.S.C. §103**

Claims 2 - 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Taniguchi et al. (U.S. Patent No. 6,511,417).

Reconsideration is respectfully requested in view of the following remarks.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness (MPEP 2142).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. The prior art reference must also teach or suggest all of the claim limitations (see MPEP 706.20(j)).

The Examiner stated,

Taniguchi et al. teaches an endoscopic system 1 comprised of an endoscope system 2 and an endoscope shape detection system 3 to be used as an in section aid means when an insertion unit 7 of an electronic endoscope 6 is inserted into a body cavity of a patient 5 (see col. 11, lines 1-35). operation unit 8 and a plurality of magnetic generation devices or coils 14a, 14b, etc. and a radio frequency signal or driving signal is applied from a main unit 21 to the source coils 14a, etc. (see Figure 1A and col. 11, lines 59-67 and col. 12, lines 1-8).

The Examiner has recited language from the referenced specification but has not made a *prima facie* case of obviousness, as a suggestion or motivation to modify the reference has not been shown. Furthermore, the Examiner has not shown how the reference teaches or suggests all of the claim limitations of claims 2 – 19. Therefore, the Applicant is under no obligation to submit evidence of nonobviousness.

Assuming, arguendo, that the Examiner has made a *prima facie* case of obviousness, Taniguchi et al. does not teach or suggest all of the claim limitations in independent claim 2. Claim 2 requires an "elongate body with a proximal end and a selectively *steerable* distal end and defining a lumen therebetween, *the elongate body comprising a plurality of segments.*" (emphasis added).

There is no teaching or suggestion in Taniguchi et al. of an endoscope that has a steerable distal end as is required by claim 2. Furthermore, Taniguchi et al. does not teach or suggest an elongate body comprising a plurality of segments as is also required by claim 2. Taniguchi et al. fails to appreciate the desirability of having a segmented body to offer a wider range of motions while directing a device through the patient's body. Particularly, Figures 48A, 54, 55, 57, 58, 59A, 61A, 62A, 64B, 65B, 66, 67C, 69-71, 74, 76A-B, 77, 78, and 79A illustrate a non-segmented device. Taniguchi et al. does not, therefore teach or suggest all of the claim limitations of claim 2. Therefore claim 2 is not obvious based on Taniguchi et al. As such, the Applicant respectfully requests the rejection to claim 2 be withdrawn.

Dependent claims 3-10 depend from independent claim 2, and therefore include all of the limitations from independent claim 2. As Taniguchi et al. does not teach or suggest all of the claim limitations of independent claim 2 for at least the reasons noted above, Taniguchi et al. does not teach or suggest all of the claim limitations of claims 3-10. Therefore, claims 3-10 are not obvious based on Taniguchi et al., and thus Applicant respectfully requests the rejection to claims 3-10 be withdrawn.

The Examiner has rejected independent claim 11 under 35 U.S.C. §103(a) as being unpatentable over Taniguchi et al. The Applicant respectfully requests withdrawal of this rejection as the Examiner has not made out a *prima facie* case of obviousness as noted above is required in a §103(a) rejection (see MPEP 2142 and 706.20(j)).

Assuming arguendo, that the Examiner has made a *prima facie* showing of obviousness, Taniguchi et al. does not teach or suggest all of the claim limitations of independent claim 11 and is

thus not obvious in light of Taniguchi et al. Taniguchi et al. does not teach or suggest tracking the position of a transponder on the instrument “using a navigation system” as required by claim 11. Taniguchi teaches and discloses a “shape detection system 3” and thus teaches a system that detects a shape of a body, not a navigation system. (Col. 11, lines 31-32).

Furthermore, Taniguchi et al. does not teach or suggest displaying the position of the instrument “in relation to the space in the body” as is required by claim 11. Taniguchi et al. teaches a shape detection system, but does not teach or suggest displaying a position of a device in relation to the space in the body. As stated in the specification of Taniguchi et al., “[i]n the normal mode, a model representing the shape of the endoscope like the one shown in FIG. 24 is displayed on the monitor 25 of the endoscope shape detection system 3.” (Col. 28, lines 1-3). As can be seen from Figure 24, the shape of the device is the sole image on the screen, and specifically, is not shown in relation to the space in the body of the patient. Furthermore, Figures 2, 26, 35, 39, 48A, 54, 55, 57, 58, 59A, 61A, 65B, 66, 67C, 69-71, 74, 76A-B, 77, 78 also do not display the position of the instrument in relation to the space in the body of the patient. While Figure 64B may show the position of the instrument in relation to a body part (i.e., the hand), it does not show the position of the instrument in relation to the space *in* the body of the patient.

Thus, as Taniguchi et al. does not teach or suggest all of the claim limitations in claim 11, claim 11 is not obvious based on Taniguchi et al. Independent claims 12-19 all depend from claim 11, and thus include all of the limitations of claims 11. As such, Tanuguchi et al. does not teach or suggest all of the claim limitations of dependent claims 12-19 for at least the reasons noted above. The Applicant thus respectfully request that the rejection to claims 11-19 be withdrawn.

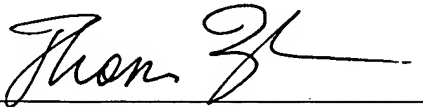
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**CONCLUSION**

Applicant submits that pending claims 2-19 are in condition for allowance which is respectfully requested. Should the Examiner have any questions, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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